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10/062,649	01/31/2002	John C. Chang	56342US011	2158

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EXAMINER

FEELY, MICHAEL J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,649

Applicant(s)

CHANG ET AL.

Examiner

Michael J Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9,11-13,15 and 16 is/are rejected.
- 7) ☒ Claim(s) 4,8,10,14 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Pending Claims

1. Claims 1-17 are pending.

Claim Rejections - 35 USC § 112 1st Paragraph

2. The rejection of claims 5, 11, and 15 under 35 U.S.C. 112, first paragraph, has been overcome by amendment.

Claim Rejections - 35 USC § 112 2nd Paragraph

3. The rejection of claims 5, 11, and 15 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.

Claim Objections

4. The objection to claims 6, 12, and 16 has been overcome by amendment.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. The rejection of claims 1, 3, 6, 7, 9, 12, 13, and 16 under 35 U.S.C. 102(e) as being anticipated by Sawatsky (US Pat. No. 6,346,315) stands for the reasons set forth in section 7 of the previous Office Action.

Claim Rejections - 35 USC § 103

7. The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Sawatsky (US Pat. No. 6,346,315) stands for the reasons set forth in section 9 of the previous Office action.

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8. The rejection of claims 1-3, 5-7, 9, 11-13, and 15-16 under 35 U.S.C. 103(a) as being unpatentable over Casalini (Canadian publication 2,315,728) stands for the reasons set forth in section 10 of the previous Office action.

Allowable Subject Matter

9. Claims 4, 8, 10, 14, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. These claims would be allowable for the reasons set forth in section 12 of the previous Office action.

Response to Arguments

11. Regarding the rejections over Sawatsky, Applicant argues that the organo-functional silicone material used by Sawatsky only provides adhesion properties – not protective properties, and that only the subsequent layers provide protective properties.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., protective properties of the polysiloxane) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims are directed to a "method for protecting a substrate" and a product produced by the method, wherein the method comprises: a) providing a substrate with at least one surface; b) applying an "overlay thermosettable resin" to at least part of the surface; c) applying a substituted polysiloxane to at least part of the surface, wherein at least a portion of the "overlay

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thermosettable resin” and a least a portion of the polysiloxane are applied to the same part of the surface; and d) at least partially curing the “overlay thermosettable resin”. The *collection of process steps* provides protection to the substrate – not specifically the polysiloxane material.

12. Also regarding the rejections over Sawatsky, Applicant argues that the claimed polysiloxane is within the uppermost layer, and that Sawatsky fails to teach this layer orientation.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., polysiloxane in the uppermost layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

There is no mention of an “uppermost layer”. The “overlay thermosettable resin” is applied to *at least part of the substrate surface*, and the substituted polysiloxane is applied to *at least part of the substrate surface*, wherein at least a portion of said overlay and at least a portion of said polysiloxane are applied to *the same part of the surface*. This limitation can be satisfied by: 1) applying the overlay to the substrate and applying the polysiloxane on top of the overlay; 2) applying the polysiloxane to the substrate and applying the overlay on top of the polysiloxane; and 3) applying the polysiloxane and the overlay together to the substrate.

13. Regarding the rejections over Casalini, Applicant argues that Casalini fails to teach or suggest that the polysiloxane provides improved anti-soiling resistance.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., anti-soiling resistance of the polysiloxane) are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims provide not mention of anti-soiling resistance. Applicant also states that they have discovered that providing polysiloxane to a substrate provides improved anti-soiling resistance; however, it is widely recognized that certain polysiloxanes provide low surface energy, which leads to anti-soiling properties.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely
September 15, 2003

A handwritten signature in cursive script that reads "Robert A. Dawson". The signature is written in black ink and is positioned above the printed name and title.

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700